

REMARKS

All of the original claims 1-26 filed in the above identified application have been rejected under 35 USC § 103(a). Various other original claims have been rejected under 35 U.S.C. §112, as explained below. Claims 1, 3, and 21 have been amended. New claims 27-29 have been added. Claims 1-29 are currently pending.

Claim 1 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Applicants have amended claim 1 in order to overcome this rejection. Applicants thank the Examiner for careful review of the claims.

The Drawing has been objected to under 37 CFR § 1.83(a) based on an asserted failure to show the claimed features regarding the “second path.” Applicants traverse this objection and see no reason to correct the Drawing because the primary features associated with the “second path” are already clearly shown in Figs. 10 and 12-13 while corresponding ancillary features are shown in Figs. 1-9. The features of new claim 27 are also shown in Figs. 10 and 12-13.

Claims 7-15, 18-20, and 24-26 have been rejected under 35 U.S.C. 112, ¶ 1 based on a purported failure to satisfy the enablement requirement for the “second path” features. In traversing this rejection, Applicants again point to Figs. 10 and 12-13, and the description thereof in the specification of the present application (the “Specification”).

Finally, claims 1-6, 16-17 and 21-23 have been rejected under 35 USC § 103(a). Applicants also traverse this rejection as further explained below.

I. Confidentiality Issues Associated With Applications Incorporated by Reference:

Drawing attention to the Specification, the Examiner requests updated serial numbers and status information for five different co-pending applications incorporated by reference. (Office Action at ¶ 4-5.) The Examiner also states that in order to avoid a waiver of confidentiality of the entire files of the co-pending applications, the Applicants must provide two copies of the information incorporated by reference. (Id.)

Applicants strongly object to the Patent Office providing public access to the entire files of the co-pending applications. However, Applicants are not currently in a

position to provide two copies of the information incorporated by reference because the present applicant has been recently transferred to new counsel for further prosecution, while the other files have not been transferred. For the same reasons, Applicants are not currently in a position to provide updated serial numbers and status information.

Applicants fully intend to provide two copies of the information incorporated by reference, as well as updated serial numbers and status information as soon as possible. Therefore, submission of the present Amendment without copies of the information incorporated by reference should not be interpreted as a waiver of confidentiality of the entire files of the co-pending applications.

II. Objections to the Drawing:

The Examiner has objected to the Drawing under 37 CFR § 1.83(a), asserting that claimed features regarding the “second path,” (i.e., “second path,” “second active elements,” “controller for controlling the second active element,” “second carriage,” and “second tool”) must be shown in the Drawing. Applicants point out that the primary features of the “second path” are clearly shown in Figs. 10 and 12-13, while the more detailed ancillary features are appropriately shown in other figures (i.e., Figs. 1-9). The features of new claim 28 are also shown in Figs. 10 and 12-13.

With regard to a showing of the “*second path*,” “*second carriage*” and “*second tools*,” Applicants direct the Examiner’s attention to Fig. 10, which shows the first and second carriages mounted on first and second paths. The Specification states:

In a preferred embodiment ... depicted in Fig. 10, the sealing station 328 includes *first and second sealing jaw subassemblies 348 and 350*, ... These subassemblies 348, 350 include at least one carriage 352, 353 and preferably a plurality of carriages. The *carriages 352, 353 are preferably mounted on respective tracks 358, 360 along closed loop paths*.

(Specification at 19:28-33, emphasis added.)¹ The first and second tracks 358, 360 are referred to in the Specification as “closed loop *paths*.” (*Id.*, emphasis added.) Therefore, Fig. 10 clearly shows a “*second path*” at element 360, and a “*second carriage*” at element 353. (*Id.*)

Fig. 10 also shows a first and a “*second tool*” in the form of first and second

1. Reference to the Specification in the form X:Y-Z refers to page X, lines Y-Z.

sealing jaws 370, 371. (Specification at Fig. 10; and 19:31 through 20:3.) ²Therefore, Fig. 10 clearly shows a “*second tool*” at element 371. In addition, Fig. 10 shows a “*controller for controlling the second active element*” at element 42. (*Id.*) ³

The “*second active element*” of the second path is not shown in Fig. 10. However, it is illustrated in Figs. 1 and 3-5, which show “active elements” in the form of coils. (Specification at 4:19-21; 8:20-23; and Figs. 1 and 3-5.) The Specification teaches that either of the first and second paths 358, 360 shown in Fig. 10 may be implemented in accordance with the individual paths shown in Figs. 1 and 3-5, which include “active elements” in the form of coils disposed proximate the individual paths. ⁴

While the “*second reactive element*” is not shown in Fig. 10, it is shown in Figs. 3 and 4 at element 108. (Specification at 11:28-31.) The Specification teaches that either one of the first and second carriages 352, 353 shown in Fig. 10 may be implemented in the form of a carriage like the one in Figs. 3 and 4, wherein a permanent magnet (reactive element) 108 is affixed to a mounting member 101 of the carriage 100. (*Id.* at 11:28-31.)

In light of the foregoing remarks, Applicants request that the objection to the Drawing be withdrawn. For reference, Applicants point out that the features of new claim 27 are also shown in Figs. 10 and 12-13.

III. Rejections Under 35 U.S.C. § 112, First Paragraph:

Claims 7-15, 18-20, and 24-26 have been rejected under 35 U.S.C. 112, ¶ 1. The Examiner’s concern is that the claimed features associated with the “second path” may not satisfy the enablement requirement. (Office Action at ¶¶ 6-7.) Similar to the response to the Drawing objection, Applicants Examiners again direct the Examiners attention to Figs. 10 and 12-13, and pages 19-26 of the Specification, which provide a complete description of a system and method for performing a manufacturing operation relative to first and second paths.

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2. The Specification also states that “[w]hile sealing jaws and cutters were described in connection with invention, other tools may also be used” (*Id.* at 26:34-35.)
 3. The controller 42 is also shown in Fig. 1.
 4. The system shown in Figs. 10 and 12-13 is just one embodiment of the systems depicted more generally in Figs. 1-9 and 11. (*Id.* at page 19, lines 7-11.) The system of Fig. 10 is described as “employing the various features of the invention.” (*Id.* at 19:7-8.) Also, Figs. 1 and 10 show the same controller 42, thereby linking the Figs. 1 and 10.

It is clear that the Specification enables a person of ordinary skill in the art to make and use at least one embodiment of the two-path invention recited in claims 7-15, 18-20, and 24-26. In particular, the Specification describes the structure and operation of a form, fill, and seal packaging machine for performing a manufacturing operation relative to first and second paths. (Specification at Figs. 10 and 12-13, and pp. 19-26.) Applicants assert that claims 7-15, 18-20, and 24-26 read on this embodiment.⁵ The enablement requirement is met if the description enables *any mode* of making and using the claimed invention. Engel Industries, Inc. v. Lockformer Co., 946 F.2d 1528, 20 USPQ2d 1300 (Fed. Cir. 1991). Because the Specification enables at least one embodiment of the invention recited in claims 7-15, 18-20, and 24-26 (i.e., the form, fill, and seal packaging machine for performing a manufacturing operation relative to first and second paths), the Specification satisfies the enablement requirement for the invention recited in claims 7-15, 18-20, and 24-26.

As explained above in the response to the objection to the Drawing, the Specification provides complete support for : (1) a “*second path*” (see Specification at element 360 of Fig. 10; and 19:28-33); (2) a “*second carriage*” (see *id.* at element 352 of Fig. 10; and 19:28-33); (3) a “*second tool*” in the form of second sealing jaws (see *id.* at element 371 of Fig. 10; and 19:31 through 20:3); (4) a “*second active element*” (see *id.* at Figs. 1 and 3-5; and 4:19-21; 8:20-23); (5) a “*second reactive element*” (see *id.* at Figs. 3-4; and 11:28-31); and (6) a “*controller for controlling the second active element*” (see *id.* at element 42 of Fig. 10; and 19:31 through 20:3).

In the Office Action, the Examiner directs attention specifically to claim 7 and questions the Specifications support under 35 U.S.C. 112, ¶ 1 for the last clause, which recites “wherein the first tool associated with each first carriage cooperates with the second carriage to perform the manufacturing operation.” (Office Action at ¶ 7.) Applicants point out that the use of the first tool to cooperate between the first and second carriages is shown in Fig. 10, and explained in great detail at pages 19-26.

5. As described in the Specification, the present invention including claims 7-15, 18-20, and 24-26 is certainly not limited to use in a packaging machine. (Specification at 26:27-27:1.) Other embodiments are also considered to be within the scope of the invention as would be understood by a person of ordinary skill in the art.

For the Examiners reference, the features of new claim 27 are also enabled by the illustration and description provided by Figs. 10 and 12-13, and pages 19-26 of the Specification. The features of new claims 28-29 are shown and described primarily with reference to Figs. 6 and 6a.

Rejections Under 35 U.S.C. § 112, Second Paragraph:

Claim 1 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regard as their invention. (Office Action at ¶¶ 8-9.) The Examiner asserts that the limitation of "a first tool associated with each first carriage ..." as stated in the previous claim 1 is not clearly defined as to how Applicants define "associated." The Examiner asks: is the "first tool" is within the carriage or located nearby to the carriage in its path of transport ? The Examiner's question is addressed below.

In order to correct the problem pointed out by the Examiner, Applicants have amended claim 1 to recite,

a first tool associated with each first carriage for performing at least part of the manufacturing operation, the first tool interacting with the associated first carriage during the relative movement between the associated first carriage and the first path;

(See Amendments to the Claims, Supra.)

Literal support for the underlined added limitation, recited above, is found in the originally filed Specification at page 26, line 27 through page 27, line 2. No new matter has been added. The Specification uses the phrase "interacts with" to describe the association between a "carriage" and an associated "tool." (See, e.g., Specification at 26:30.) More particularly, the Specification states:

Any type of manufacturing or other process is anticipated to derive some benefit from the invention, particularly *where a movable element interacts with a tool along a path.*

(Specification at 26:30, emphasis added.) ⁶

A person of ordinary skill in the art would understand that the tool need not be permanently affixed to the carriage in order to "interact with" the carriage, as suggested

6. The Specification uses the term "movable element" interchangeably with "carriage." (*Id* at 7:2.)

in the above cited portion of the Specification. Therefore, in response to the Examiners question (i.e., is the "first tool" is within the carriage or located nearby to the carriage in its path of transport ?), Applicants believe that the amended independent claim 1 reads on embodiments wherein the tool is located "within the carriage" *and* embodiments wherein the tool is "located nearby to the carriage in its path of transport." Applicants assert that the Specification provides support for: (a) embodiments wherein a tool "*interacts with*" a carriage in terms of being carried by or affixed to the carriage (*see, e.g.,* Specification at Fig. 10: tools 370 and 371 affixed to carriages 352 and 353 respectively); and (b) embodiments wherein the tool is moved by the carriage without actually being affixed to it (*Id.* at 26:27 through 27:2).

IV. Claim Rejections Under 35 USC §103

Claims 1-6, 16-17 and 21-23 have been rejected under 35 USC § 103(a) as being unpatentable over Brian (U.S. Patent No. 4,005,349) in view of Prucher (U.S. Patent No. 4,633,148).

A. None of the Cited References, Taken Individually or Collectively, Teaches Use Of "A Plurality of Rows of Switching Sensors" As Recited In Amended Independent Claims 1 And 21

Independent claim 1 has been amended to recite:

a plurality of rows of switching sensors arranged along said first path, each said row being operatively associated with at least one of said first carriages, each sensor of a particular one of said rows enabling a corresponding switching signal when said associated first carriage enters into proximity of said sensor

(See Amendments to the Claims, *Supra.*) Support for this amendment is found in the Specification at Figures 6, 6a, 9 and 11 and pages 15-16. (Specification at elements 200, 202, 204, and 206 of Fig. 6; elements 200, 12a, 12b, 14a and 14b of Fig. 6a; "Hal effect sensors" at Fig. 9; and elements 12 and 14 of Fig. 11.) No new matter has been added.

Independent claim 21 has been amended to recite:

arranging a plurality of rows of switching sensors along said first path;

operatively associating a particular one of said rows with at least one of said first carriages, each said sensor of said particular row enabling a corresponding switching

signal when said associated first carriage enters into proximity of said sensor;

(See Amendments to the Claims, Supra.) The same portions of the Specification cited for support of the amendments to claim 1 also provide support for the limitations added to claim 21. Accordingly, no new subject matter has been added.

None of the cited references teaches the feature of “a plurality of rows of switching sensors,” as found in each of the amended independent claims 1 and 21. This feature provides the advantage of “independent movement” of different carriages along the first path. Because different carriages are operatively associated with different rows of switching sensors, the controller provides more efficient control of different carriages as they are moved along different portions of the first path.

Because none of the cited references teaches the feature of “a plurality of rows of switching sensors,” amended independent claims 1 and 21 are patentable over the cited references. Claims 2-20 and 22-26 depend from patentable claims 1 and 21 respectively, rendering them patentable also. The feature of a plurality of rows of switching sensors is also found in new claims 28 and 29, rendering these claims patentable as well.

B. None of the Cited References, Taken Individually or Collectively, Teaches A System and Method for Performing a Manufacturing Operation Relative to First and Second Paths As Set Out in Claims 7 and 24

Claims 7 and 24 both recite a “second path,” “second carriages,” and cooperation between the first and second carriages to perform a manufacturing operation. None of the cited references teaches a system and method for performing a manufacturing operation relative to first and second paths. As explained above, the Specification as originally filed provides support for claims 7 and 24 both in terms of enablement and in the Drawing. Therefore, Applicants assert that claims 7 and 24 are patentable and early notification of allowance is requested. Claims 8-15 and 25-26 depend from patentable claims 7 and 24 respectively, rendering them patentable also. The features of a “second path,” “second carriages,” and cooperation between the first and second carriages to perform a manufacturing operation are also found in new claims 27-28 rendering these claims patentable as well.

CONCLUSION

Thus, in light of the above, having responded to each and every ground of rejection, Applicants respectfully request reconsideration and allowance of the pending claims in the above-mentioned application.

Respectfully submitted,

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